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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GRAINGER, QUANA MASHELL

ART UNIT PAPER NUMBER

2852

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,912

Applicant(s)

RUSSEL ET AL.

Examiner

Quana Grainger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,7-10,12,13 and 17-41 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 2,7-10,12,13 and 17-37 is/are rejected.
- 7) ☒ Claim(s) 38-41 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action: (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-3, 5, 8, 11-13, 17, 19, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Funada et al. Sato teaches a data monitoring method comprising: monitoring each copy element of monitoring object data consisting of at least one kind of copy element in accordance with at least one kind of copy inhibition information and stored in inhibition information storage and inhibiting input or output of the monitoring object data if the monitoring determines that said each copy element agrees with a kind of said copy inhibition information (abstract solution: lines 1- end, copy element is consistent with an original; decision means determines if image data is consistent with illegal image data).

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Sato teaches a data monitoring device comprising an inhibition information storage storing at least one kind of copy inhibition information monitoring means monitoring at least one kind of copy element prepared from monitoring object data based on the copy inhibition information and inhibition means inhibiting input or output of the monitoring object data if said at least one copy element included in the monitoring object data agrees with one of the copy inhibition information (abstract solution: lines 1- end).

Sato does not teach copy inhibition information capable of being updated and stored in inhibition information storage.

Funada et al. teaches a data monitoring device further comprises updating means updating the copy inhibition information copy inhibition information capable of being updated and stored in inhibition information storage. Funada et al. teaches a data monitoring method in which updating information of the copy inhibition information is provided passing through a network. The data monitoring method further comprising: obtaining the copy inhibition information by requesting to a master information storage when originals of the copy inhibition information are stored in the master information storage on the network. The data monitoring method further comprises storing updating logs when the copy inhibition information stored in the inhibition information storage is updated and in which in the step of updating copy inhibition information, the updating should be executed only when the updating information of the copy inhibition information is later than the stored log information (abstract constitution: lines 1- end; updating means updates the current contents of a means that stores the contents).

The data monitoring method comprises canceling a function of stopping the copying after confirming if a user has a right to cancel the monitoring function or not. The data monitoring

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device further comprises updating means updating the copy inhibition information. The updating means inhibits the updating when the updating is not executed by a user having a right to update and the copy inhibition information has the management information of the updating right as an attribute. The data monitoring device further comprising: a master information storage on the network storing originals of the copy inhibition information and information obtaining means obtaining the copy inhibition information by requesting to the master information storage (abstract constitution: lines 1- end, updating means updates the current contents of a means that stores the contents; this contents is used when checking an object picture).

Funada et al. teaches a copying device receiving an monitoring object data from an external device and preparing a copy based on the monitoring object data, comprising extracting means analyzing the monitoring object data and extracting unique information specifying a specific device concerned with the preparation of the monitoring object data and specific information imparting means imparting the extracted unique information to the monitoring object data. The unique information is an ID number specifying a personal computer.

Sato in view of Funada et al. does not suggest a data monitoring method in which in the step of updating the copy inhibition information, the updating should be valid only when an authorized person executes the updating. The data monitoring device in which the updating means inhibits the updating when the updating is not executed by a user having a right to update and the copy inhibition information has the management information of the updating right as an attribute. The data monitoring device further comprising: a log storage storing updating logs when the copy inhibition information in the inhibition information storage are updated and in which the updating means obtains the latest copy inhibition information based on the logs of the

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updating information. The examiner takes official notice that it is known in the art to use an ID number to specify a personal computer or an IP address imparted to a device. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of Funada et al. with the image forming device of Sato to provide updates to the copy inhibition information as needed as copy inhibited documents change.

4. Claims 4, 14-16, and 34-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Funada et al., and further in view of Takagi. Sato does not teach providing updating information for the copy inhibition information by a removable storage media.

Takagi teaches a data monitoring method in which updating information of the copy inhibition information is provided by a removable storage media. The data monitoring method in which updating information of the copy inhibition information is provided by an information providing medium. The data monitoring device in which the updating information is provided by a removable storage medium. The updating information is obtained from an information providing medium. The storage medium storing programs comprises monitoring each copy element being monitoring object data consisting of at least one kind of copy element in accordance with at least one kind of copy inhibition information capable of being updated and stored in inhibition information storage and inhibiting to input or output the monitoring object data if the monitoring determines that said each copy element agrees with a kind of said copy inhibition information. The storage medium storing a program comprises controlling a copy inhibition or a inhibition cancel in accordance with secrecy management information and user's secrecy management level, said secrecy management information stored in the inhibition information storage in addition to the copy inhibition information in advance. The copy

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inhibition information is obtained passing through the network (abstract constitution: lines lend).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of Takagi for providing the inhibition information on a portable device with the inhibition information taught by Sato to provide another method of utilizing the inhibition information storage for image forming devices.

5. Claims 7, 9-10, 18, and 20 are rejected under 35 U.S.C. '103(a) as being unpatentable over Sato in view of Funada et al., and further in view of Ishii. Sato does not teach secrecy management information.

Ishii teaches a data monitoring method further comprising controlling a copy inhibition or a inhibition cancel in accordance with secrecy management information and user's secrecy management level, said secrecy management information stored in the inhibition information storage in addition to the copy inhibition information in advance. The data monitoring device further comprises secrecy management means storing in the inhibition information storage secrecy management information in addition to the copy inhibition information, and controlling a copy inhibition or an inhibition cancel in accordance with secrecy management information and user's secrecy management level (abstract constitution: lines 1- end, registered ID is consistent with secrecy management information and user ID is consistent with user's secrecy management level).

The data monitoring method comprises controlling a copy inhibition or a inhibition cancel in accordance with secrecy management information and user's secrecy management level, said secrecy management information obtained together with the copy inhibition information at the step of obtaining the information, said secrecy management information stored

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in the master inhibition information storage in addition to the original copy inhibition information in advance. The master storage stores secrecy management information of each original information in addition to the copy inhibition information; the information obtaining means obtains the copy inhibition information and the secrecy management information and further comprising secrecy management means controlling a copy inhibition or a inhibition cancel in accordance with the obtained secrecy management information and user's secrecy management level (abstract solution: lines 1- end). The examiner takes official notice that it is known in the art to prevent non supervisory users from canceling or altering monitoring functions within an image forming device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of Ishii with the image forming device of Sato to prevent unspecified users from using the device.

6. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Funada et al. and further in view of Omura (JP403120561A). Sato does not teach providing user with releasing codes for copy prohibition.

Omura teaches a data monitoring device further comprising canceling means canceling a function of stopping the copying after confirming if a user has a right to cancel the monitoring function or not. Omura teaches a copying device comprising first specific information extracting means extracting an ID information unique to a specific device concerned with the preparation of monitoring object data and information imparting means imparting the ID information to the monitoring object data and preparing a new copied data. The ID information is chip ID information imparted to Central Processing Unit (CPU). The ID information is an IP address imparted to a device. Omura teaches a copying device comprising second specific information

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extracting means extracting a specific application information unique to software concerned with the preparation of monitoring object data and information imparting means imparting the specific application information to the monitoring object data and preparing a new copied data. The specific application information is a mail address registered by a user (abstract constitution: lines 1- end). It would have been obvious to one of ordinary skill in the art at the time the invention was made use the teaching of Omura with the image forming

7. Claims 30-33 and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Funada et al., and further in view of Ugai (JP406125459A). Sato does not a specific information imparting means.

Ugai teaches a copying device adapting to the network of receiving an monitoring object data from an external device and preparing a copy based on the monitoring object data, comprising: extracting means extracting an IP address imparted to the copying device and specific information imparting means imparting the extracted IP address to the copied data as new copied data. Ugai teaches a copying device receiving an monitoring object data from an external device and preparing a copy based on the monitoring object data, comprising: extracting means analyzing the copied data and extracting unique information specifying specific software concerned with the preparation of the copied data and specific information imparting means imparting the extracted unique information to the copied data as new copied data. The unique information is a mail address registered by a user. The unique information is registration information of software (abstract constitution: lines 1- end; mark addition is a specific information imparting means).

Ugai teaches a storage medium executed by a copying apparatus preparing a copy

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according to monitoring object data after receiving the monitoring object data from an external device or after preparing the monitoring object data by itself, which storing programs comprising extracting ID information unique to a specific device concerned with the preparation of the monitoring object data and imparting the ID information to the monitoring object data and preparing a new copied data. Ugai teaches a storage medium executed by a copying apparatus preparing a copy according to monitoring object data after receiving the monitoring object data from an external device or after preparing the monitoring object data by itself, which storing programs comprising: extracting specific application information unique to software concerned with the preparation of the monitoring object data; and imparting the specific application information to the monitoring object data and preparing a new copied data (abstract constitution: lines 1- end). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of use the teaching of Ugai et al. with the image forming device of Sato to prevent the illegal copying of special originals and to trace when special original are attempted to be copied.

Allowable Subject Matter

Claims 38-41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments that the applied art is concerned with the copying of money and other illegal documents and that the process of updating and recording the updating history is not performed as often as in the instant invention. However, the claims do not differentiate

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themselves with respect to this difference. The claims remain rejected as discussed above and claims 38-41 are addressed.

Please note that applicant did not officially instruct the patent office to delete claims 1, 5, 11, and 16 and this format of deleting claims have caused confusion when the application is ready for printing.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quana Grainger whose telephone number is 571-272-2135. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Arthur Grimley can be reached on 703-308-1373. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Quana Grainger
Primary Examiner
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QG
February 22, 2004